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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,626	12/08/2000	G. Scott Barbieri	B0932/7158/REH	2410

7590 05/06/2002

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Boston, MA 02210

EXAMINER

MAR, MICHAEL Y

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/733,626

Applicant(s)

Barbieri et al

Examiner

Michael Mar

Art Unit

3618



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 and 52-99 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 and 52-99 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Applicant's election with traverse of the specie shown in Figs. Ia, Iib and IIIb in Paper No. 10 is acknowledged. The traversal is on the ground(s) that searching all of the species would not place a serious burden on the Examiner. This is not found persuasive because applicant has not submitted evidence or identified such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

The requirement is still deemed proper and is therefore made FINAL.

### **Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-48 and 52-99 are rejected under 35 U.S.C. 112, second paragraph, in view 37 C.F.R. 1.75(b), on the grounds of multiplicity. It has been held that the presentation of a large number of claims may pose a burden to the PTO and the courts, not justified by the extent of Applicants' interest in latitude in claiming the invention. (Applicant's latitude in stating their claims in regard to number and phraseology employed "should not be extended to sanction that

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degree of repetition and multiplicity which beclouds definition in a maze confusion.”). In re Chandler, 117 USPQ 361 (CCPA 1958). See also MPEP 2173.05(n).

The application as filed contains ninety six claims.

While the Examiner does not take the position that applicants should be precluded from submitting claims defining their invention, the number of claims pending for examination is in excess of a reasonable number with which to claim the invention.

Particularly in the context of 37 C.F.R. 1.75 and the cited opinions, and to the repitive nature of the claims, rejection on the grounds of multiplicity is appropriate.

Even though the rejection may be traversed, applicant is required in response to this action to designate no more than a total of twenty claims for examination on the merits.

The designation of up to the indicated numbers of claims would provide applicant ample latitude in claiming the invention, would be reasonable in view of the state of the art and the nature of the invention, and is necessary to permit a complete examination without the imposition of serious burden on the Office.

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Applicants' are advised that should they wish to traverse the rejection previously outlined, that in addition to pointing out alleged errors in the multiplicity rejection, reasons for traversal should also be addressed.

Applicant is advised that should it be traversed and repeated, this is an appealable ground of rejection.

4. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to *Group Art Unit 3618*.

5. **Any response to this action should be mailed to:**

Assistant Commissioner for Patents

Washington, D.C. 20231

**or faxed to:**

(703) 308-2571

(for formal communications intended be entered)

(all informal communications should be labeled "PROPOSED" OR "DRAFT")

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**or hand delivered to:**

Crystal Park 5, 2451 Crystal Drive, Arlington, Virginia 22202

Seventh Floor(receptionist)

6. Any inquiry concerning this communication should be directed to Michael Mar at telephone number (703) 308-2087 between the hours of 10:00 AM and 7:00 PM, Monday-Friday or by e-mail at: **michael.mar@uspto.gov**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



**MICHAEL MAR**

**Primary Examiner**

M.Mar

May 4, 2002